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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,997	12/10/2001	Jacqueline K. Barton	CIT1290-1	3460

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EXAMINER

WHISENANT, ETHAN C

ART UNIT PAPER NUMBER

1634

DATE MAILED: 03/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,997

Applicant(s)

BARTON ET AL.

Examiner

Ethan Whisenant, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claim(s) 1-27 are pending in this application.

SEQUENCE RULES

2. This application now complies with the sequence rules and the sequences have been entered by the Scientific and Technical Information Center.

35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that may form the basis for rejections set forth in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) The invention was described in --

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a)

CLAIM REJECTIONS UNDER 35 USC § 102

- 4.** Claim(s) **1-23 and 26-27** is/are rejected under 35 U.S.C. 102(e) as being anticipated by Barton et al. [US 6,031,098 (29 February 2000)].

Barton et al. teach a compound of the formula recited in Claim 1 as well as the use of said compound in conjunction with oligos specific for a polynucleotide sequence of interest in a method of detecting base-pair mismatches in a nucleic acid duplex.

- 5.** Claim(s) **1-9 and 26-27** is/are rejected under 35 U.S.C. 102(b) as being anticipated by Dandliker et al. (1998).

Dandliker et al. teach a compound of the formula recited in Claim 1 as well as the use of said compound to detect/repair a thymine dimer in a nucleic acid duplex.

35 USC § 103

- 6.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 7.** This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligations under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

CLAIM REJECTIONS UNDER 35 USC § 103

- 8.** Claim(s) 24-25 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton et al. [US 6,031,098 (29 February 2000)] in view of the Stratagene Catalog (1988)

Barton et al. teach a compound of the formula recited in Claim 1 as well as the use of said compound in conjunction with oligos specific for a polynucleotide sequence of interest in a method of detecting base-pair mismatches in a nucleic acid duplex. Barton et al. do not teach a kit comprising said compound and/or one or more oligos specific for a polynucleotide sequence of interest. However, the Stratagene catalog (1988, p.39) does teach the advantages of assembling a kit, such as, saving resources and reducing waste. Therefore, absent an unexpected result it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to place the reagents disclosed by Barton et al. into separate containers and then package these containers into a single article of manufacture (a kit) for the expected benefits of convenience and cost-effectiveness. This modification would allow the ordinary artisan to perform the method of Barton et al. in the most cost efficient manner.

- 9.** Claim(s) 24-25 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Dandliker et al. (1998) in view of the Stratagene Catalog (1988).

Dandliker et al. teach a compound of the formula recited in Claim 1 as well as the use of said compound to detect/repair a thymine dimer in a nucleic acid duplex. Dandliker et al. do not teach a kit comprising said compound and/or one or more oligos specific for a polynucleotide sequence of interest. However, the Stratagene catalog (1988, p.39) does teach the advantages of assembling a kit, such as, saving resources and reducing waste. Therefore, absent an unexpected result, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to place the reagents disclosed by Dandliker et al. into a container(s) and then package said container(s) into a single article of manufacture (a kit) for the expected benefits of convenience and cost-effectiveness. This modification would allow the ordinary artisan to perform the method of Dandliker et al. in the most cost efficient manner.

NONSTATUTORY DOUBLE PATENTING

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. **Claim(s) 1-9** is/are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-11 of U.S. Patent No. 6,031,098. Although the conflicting claims are not identical, they are not patentably distinct from each other.

12. **Claim(s) 10-16, 19-23** is/are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-10 of U.S. Patent No. 6,306,601. Although the conflicting claims are not identical, they are not patentably distinct from each other.

13. **Claim(s) 17** is/are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-7 of U.S. Patent No. 6,444,601. Although the conflicting claims are not identical, they are not patentably distinct from each other.

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14. Claim(s) 24-26 is/are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-10 of U.S. Patent No. 6,306,601 as applied against Claim 1 above and further in view of the Stratagene Catalog (1988).

Claims 1-10 of U.S. Patent No. 6,306,601 teaches all of the limitations of Claims 24-25 except these claims do not explicitly teach a kit comprising the compound of Claim 1 (i.e. reagents necessary to carry out the method recited in Claim 10 of the instant application). However, as evidenced by the Stratagene Catalog teaching, it was well known at the time of the invention to place the reagents needed to perform a nucleic acid based assay into a kit format. Therefore, absent an unexpected result, it would have been *prima facie* obvious to the ordinary artisan at the time of the invention to modify the teachings of Claims 1-10 of U.S. Patent No. 6,306,601 with the teachings of the Stratagene Catalog wherein the reagents necessary to perform the method recited in Claims 1-10 of U.S. Patent No. 6,306,601 are placed into a kit format. The ordinary artisan would have been motivated to make this modification in order to take advantage of the savings and efficiency afforded by kits.

CONCLUSION

15. Claim(s) 1-27 is/are rejected and/or objected to for the reason(s) set forth above.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant, Ph.D. whose telephone number is (703) 308-6567. The examiner can normally be reached Monday-Friday from 8:30AM -5:30PM EST or any time via voice mail. If repeated attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152.

The fax number for this Examiner is (703) 746-8465. Before faxing any papers please inform the examiner to avoid lost papers. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989). Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-0196.



Ethan Whisenant, Ph.D.
Primary Examiner